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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/660,470 | 09/12/2003 | Tor Rafael Lund | 134/125 | 4956 |
| 7590 | 10/25/2004 | | EXAMINER | |
| Averill & Varn 8244 Painter Ave. Whittier, CA 90602 | | | WILLATT, STEPHANIE L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3732 | |

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|------------------------------|------------------------|---------------------|--|
| | 10/660,470 | LUND ET AL. | |
| Examiner | Art Unit | | |
| Stephanie L. Willatt | 3732 | | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 September 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 8 and 10 is/are allowed.

6) Claim(s) 1-7, 11, 13 and 14 is/are rejected.

7) Claim(s) 9 and 12 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12 Sept. 2003.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____ .

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: on page 1 of the specification, line 5, "60/411,471" should be changed to --60/411,476--.

Appropriate correction is required.

Claim Objections

2. Claims 1, 3-6 and 9-12 are objected to because of the following informalities:

- In the preamble of claim 1, "finger and toe nail" should be changed to --fingernail and toenail--.
- In line 10 of claim 1, "the depression" should be --a depression--since there is no antecedent basis for "the depression".
- In lines 9-10 of claim 3, "means for energizing said at least one light source" should be changed to --said means for energizing said light source--, since the "means for energizing" was already recited in claim 2 and "said light source" was not previously recited as "at least one light source".
- In claim 4, "said holder has a recess along a top edge thereof for supporting said pair of nail clippers" should be changed to --said recess for holding said pair of nail clippers is located along a top edge of the

holder--, since the "recess for holding said pair of nail clippers" was already recited in claim 3.

- The last two lines of claim 5 state that the bulb is "held so that it's tip is within at least about one-eighth of an inch from a finger tip portion of the subject's' [sic] finger". Is the bulb held by the user so that it is one-eighth of an inch from a finger tip portion of the user, or is this language supposed to mean that the bulb is *positioned* on the holder at a distance of one-eighth of an inch from a finger tip portion of the subject's finger when the subject's finger is located so that the fingernail is between the upper and lower blades? For purposes of examination, the first meaning is being used.
- In the last line of claim 5, "subject's's" should be changed to --subject's--.
- Claim 6 states that the tip is "aimed outwardly away from the cutting end of the holder". However, the tip seems to be aimed in the general direction of the cutting end in all of the drawings, and it seems that the tip would have to be aimed toward the cutting end in order for the finger tip of the user to be illuminated. Perhaps applicant was trying to recite that the tip is not aimed directly at the cutting end of the holder. However, the tip *is* aimed in the general direction of the cutting end.
- In claim 9, --when the finger is in a cutting position with the fingernail located in the space between said upper and lower blades-- should be inserted at the end of the last line. This insertion would clarify that the

finger is not part of the apparatus and that the apparatus is configured for certain positioning of a finger when the apparatus is in use.

- In claim 10, "whereby the recess functions as a nail clipping holder" should be deleted since it is already recited in the beginning of claim 10.
- In line 1 of claim 11, "comfortably" should be deleted because inanimate objects do not experience comfort.
- In lines 9-10 of claim 11, "the depression" should be --a depression-- since there is no antecedent basis for "the depression".
- In line 9 of claim 12, "or" should be changed to --of--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 5 recites the position of the bulb with respect to the finger tip of a user. This recitation is vague and indefinite because the finger tip of the user is not part of the apparatus and can moved to any location with respect to the apparatus.

- Regarding claim 11, the phrase "of the type" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 11, 13, and 14, as best understood by the examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Ohori.

Ohori discloses an ergonomic handle for supporting a nail clipper (11) having an upper arm (leg 12) and a lower arm (leg 12). Each arm (12) has a blade end (jaw 14) and a joined end. The upper and lower arms (legs 12) are joined at their joined ends and the upper arm has an upper blade at its blade end (jaw 14) and the lower arm (leg 12) has a lower blade at its blade end (jaw 14). The upper and lower blades are aligned to meet to form a cutting line. An operating lever (17) is held to the pair of nail clippers (11) so that the depression of the operating lever causes the upper blade to move

downwardly and meet the lower blade to create a cutting action. The hand graspable handle is of sufficient girth and length to permit a user's hand to surround the graspable handle so that the user's palm is on a first side of the handle and a user's fingers grasp the opposite side and the user's thumb extends over a top edge of the hand graspable handle, since it would be possible to hold most fingernail clippers in this position.

A nail clipper recess is formed on the top edge and is shaped to surround sides of a pair of nail clippers, as shown in Figure 7 and explained in column 4, lines 30-37. The recess has a bottom upon which a pair of nail clippers (11) can rest and a back end portion (recess 26) to prevent the rearward movement of the pair of nail clippers (11) with respect to the handle. The nail clipper recess has an open front end (adjacent the rounded lip 31) to permit a user to insert a fingernail in a clipping portion of the pair of nail clippers (11). A pair of nail clippers (11) can be easily supported by a user's hand during a nail clipping operation, as discussed in column 5, lines 34-36. The nail clipper recess has an upwardly extending tab (post 33) for passing through a hole in a rear end of the pair of nail clippers (11), as discussed in column 6, lines 22-29. The part of the handle (retainer 10) leading up to the front wall (29) curves upwardly toward its front end, as shown in Figures 2 and 3.

7. Claims 1-7, as best understood by the examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Rende.

Rende discloses a nail clipping assembly including a pair of clippers for clipping a fingernail or toenail. The nail clippers have an upper arm and a lower arm (elongate

member 12,14). Each arm has a blade end (16,18) and a joined end and the upper and lower arms (elongate member 12,14) are joined at their joined ends. The upper arm (elongate member 12) has an upper blade at its blade end (16) and the lower arm (elongate member 1) has a lower blade at its blade end (18). The upper and lower blades (16,18) are aligned to meet to form a cutting line. An operating lever (26) is held to the pair of nail clippers so that the depression of the operating lever causes the upper blade (16) to move downwardly and meet the lower blade (18) to create a cutting action.

A light source (46) is held near the upper and lower blades (16,18) and is positioned so that when a finger is moved so that an extending nail portion at a distal end of the finger moves between the upper blade (16) and the lower blade 18), the light source (46) will illuminate at least that portion of the interior of the finger under its nail so that an intersection between the extending portion of the nail and the finger is clearly visible. The light source (46) is positioned below the lower blade (18), as shown in Figure 4. The light source (46) illuminates the "region beyond said first end of said elongate members [12,14]", as stated in lines 37-42 of column 6, from below. Therefore, the light source (46) illuminates the intersection between the nail and the finger. A means for energizing the light source (46) includes a battery (48) and a switch, as described in column 5, lines 4-8.

A holder (housing 29, misprinted in specification as 26) has a recess along the top for holding the pair of nail clippers so that the upper (16) and lower blades (16) thereof may be moved adjacent the end of a subject's finger end and over a subject's

extending nail. The holder (housing 29) has a hand graspable handle and a cutting end. The holder (housing 29) further supports the light source at its cutting end, as shown in Figure 4. The holder (housing 29) has a receptacle (small housing 50) for holding the means for energizing the light source (battery 48 and switch). The light source (46) is a pen light, as discussed in column 5, lines 4-8. It is well known that pen lights have incandescent bulbs. The finger tip portion of the subject's finger could moved to any distance from the tip of the light bulb, since it is not fixed to the apparatus.

Allowable Subject Matter

8. Claims 8 and 10 are allowed.
9. Claims 9 and 12 would be allowable if rewritten or amended to overcome the objection set forth in this Office action.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shah and Keating disclose fingernail clippers with a nail guide. Allen, Jr. discloses a fingernail clipper with a holder. Huang and Karram et al. disclose cutting devices with lights that can be directed on the workpiece. Shaw disclose fingernail clipper with lights affixed to them.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie L. Willatt whose telephone number is 703-305-6316. The examiner can normally be reached on M-F (8:30-6:00) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stephanie Willatt
Patent Examiner
Art Unit 3732